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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,952	11/14/2003	Robert J. Greenberg	5793.3093-00	7773

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EXAMINER	
UBER, NATHAN C	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
05/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/706,952	GREENBERG ET AL.	
	Examiner	**Art Unit**	
	NATHAN C. UBER	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _10 March 2009_.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-3,6-11,13-18,21-26,28-33,36-41 and 43-45_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-3, 6-11, 13-18, 21-26, 28-33, 36-41 and 43-45_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on 10 March 2009.

2. Claims 1, 3, 6, 8-11, 13, 16, 18, 21-26, 28, 31, 33, 36-41 and 43 have been amended.

3. Claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41 and 43-45 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10 March 2009 has been entered.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-3, 6-11 and 13-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent

eligible subject matter. Here claims 1-3, 6-11 and 13-15 fail to meet the above requirements because the claims are neither tied to a particular machine nor transform underlying subject matter. Examiner notes the step in claim 1 of *determining using the computer system*, this step does not tie the method to a computer because the computer is not doing the *determining* in the broadest interpretation of this limitation.

7. Claims 16-18, 21-26 and 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a system; however the body of the claim is directed to a plurality of components. There is no further explanation or definition of *component* in the specification. Examiner applies the broadest reasonable interpretation in light of the specification to the claim language (MPEP 2111). Examiner interprets the *components* of claim 16 to be software and not structural features of a system. Therefore the system of claim 16 is interpreted to be purely software. Software *per se* is not statutory subject matter under 35 U.S.C. 101 because it is not one of the enumerated statutory classes of invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall (U.S. 2002/0116266) in view of Walker et al. (6,018,718) and in view of COSTCO.

Claims 1, 16 and 31

Marshall, as shown, discloses the following limitations:

- *identifying an enterprise unrelated to the financial institution* (see at least ¶0033, the incentive rewards program is maintained by a program administrator and multiple participant organizations engage interactions with individuals; the administrator is the financial institution, a participant organization is the enterprise),
- *arranging, by the financial institution, a relationship with the enterprise to reward a person for engaging in the non-credit behavior benefiting the enterprise* (see at least ¶0033, the incentive rewards program is maintained by a program administrator and multiple participant organizations engage interactions with individuals; inherently in order for the Marshall invention in which an administrator administers a rewards program for participating organizations to operate, the administrator and the participating organizations must have arranged a relationship; further see at least ¶0031, "…individuals accumulate time points by engaging in activities specified by the programs" and ¶0035, "…such activities may include… attending in person or remotely sales presentation, providing blood donations… engaging in volunteer activities, or a range of other activity which may be desired," the participant organizations are facilitating the interactions with the individuals and the administrator is providing the rewards for the behavior),

- *receiving, from the enterprise and using the computing system, contact information identifying a plurality of persons involved with the enterprise* (see at least ¶0080, enrolling individuals may include receiving individual contact/profile information from a third party; the third party being some party with a customer database other than the individual, i.e. a participating company/enterprise),
- *soliciting, by a financial institution, based upon the contact information and using the computing system, the plurality of persons involved with the enterprise to associate a financial account with a reward for engaging in the non-credit behavior benefiting the enterprise* (see at least ¶0113, “[i]f the program determines that the individual is not an existing enrolled member, the individual is offered the option of enrolling in the program…”),
- *associating the financial account of a person with the reward for engaging in non-credit behavior based upon a response from the person to the soliciting* (see at least ¶0031, an account associated with an individual that accumulates time points/rewards in exchange for the individual’s participation in a wide variety of activities),
- *detecting non-credit behavior of the person, the detected non-credit behavior benefiting the enterprise* (see at least ¶0031, “…individuals accumulate time points by engaging in activities specified by the programs” and ¶0035, “…such activities may include… attending in person or remotely sales presentation, providing blood donations… engaging in volunteer activities, or a range of other activity which may be desired"),
- *notifying the person of the determined reward* (see at least ¶0077, the individuals can access their account balances so see the rewards points they accumulated),

Marshall discloses than any organization may be the administrator (¶0033). However, Marshall does not specifically disclose *financial institution* or *financial accounts* or limitations particular to financial accounts. Walker, as shown, discloses a method and system in which personalized incentives are offered by a financial institution (see at least column 4, lines 18-20) to a holder of a financial account (see at least column 4, lines 18-20). Further Walker discloses the following limitation:

- *wherein a lower credit risk is associated with persons who engage in non-credit behavior benefiting the enterprise* (see at least column 7, lines 55-57, credit scores takes into account factors such as years at current job; here the enterprise is the employer of the account holder and the non-credit behavior that the account holder engages in is doing his/her job),

Walker does not specifically disclose rewarding the credit card account simply by virtue of a lower credit risk or based on an account holder's continued employment. However COSTCO, as shown, discloses a credit card company awarding account holders a reduction in annual fees on their credit card account in exchange for account holder maintaining a COSTCO membership, which benefits COSTCO (see at least COSTCO, ¶1).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the teachings of Walker and COSTCO, which teach financial institutions administering financial rewarding those financial accounts of individuals that behave in beneficial ways, with Marshall's teaching of operating a loyalty program that rewards individual account holders of the loyalty program for beneficial interactions between the individuals and other enterprises since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 2, 17 and 32:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Marshall further discloses evaluating the account balance of a customer to determine eligibility for a reward (see at least ¶0097). Marshall does not specifically disclose the following limitation. However, Walker, as shown, discloses the following limitation:

- *evaluating a credit risk of the financial account based upon a frequency at which the non-credit behavior is detected* (see at least column 7, lines 34-36, scores are "currently" used to determine the credit risk of a customer),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings disclosed by Walker to be generally known in the art (i.e. evaluating the credit risk of customers based on non-credit behavior such as replying to advertisements) to obtain information about a customer with Marshall's teaching of operating a loyalty program that rewards individual account holders of the loyalty program for beneficial interactions between the individuals and other enterprises since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 3, 18 and 33:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Further, Marshall, as shown, discloses the following limitations:

- *if the frequency at which the non-credit behavior is detected attains a certain threshold, providing for the financial account at least one of* (see at least ¶0095, "threshold levels create tangible reward thresholds that individuals can strive to reach in order to become entitles to select a specific reward offered…"),

- *a waiver of an annual fee, a credit redeemable for products, and a credit redeemable for services* (see at least ¶0015, discounted services, and ¶0031, “time points may be redeemed for products and/or services…”),

Marshall does not specifically disclose the following limitations. However, Walker, as shown, discloses the following limitations:

- *an interest rate lower than an interest rate of the financial account prior to the evaluation, a credit limit higher than a credit limit of the financial account prior to the evaluation, a monetary credit* (see at least column 9, Table II),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the rewards of Walker with the rewards of Marshall because Marshall teaches providing meaningful incentives to customers.

Claim 6, 21 and 36:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Further, Marshall, as shown, discloses the following limitation:

- *the determined reward for the financial account at least one of a waiver of an annual fee, a credit redeemable for products, and a credit redeemable for services* (see at least ¶0015, discounted services, and ¶0031, “time points may be redeemed for products and/or services…”),

Marshall does not specificallydisclose the following limitations, however, Walker, as shown, does:

- *an interest rate lower than the interest rate prior to the evaluation, a credit limit higher than the credit limit prior to the evaluation, a monetary credit* (see at least column 9, Table II),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the rewards of Walker with the rewards of Marshall because Marshall teaches providing meaningful incentives to customers.

Claim 7, 22 and 37:

The combination Marshall/Walker discloses the limitations in the rejections above. Further Marshall, as shown, discloses the following limitations:

- *associating the financial account with the enterprise if the customer is currently a customer of an institution controlling the financial account based upon the contact information* (see at least ¶0113, "[t]he information is received by the system and evaluated by the software program to determine whether the individual is an existing enrolled member"),

Claim 8, 23 and 38:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Marshall, as shown, further discloses the following limitation:

- *receiving a voucher subsequent to a performance of the non-credit behavior* (see at least Figure 5, Items 600 and 635, participant system records individual accumulation session values and sends them to the program administrator).

Claim 9, 24 and 39:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Marshall, as shown, further discloses the following limitation:

- *receiving the voucher from the enterprise* (see at least Figure 5, Items 600 and 635, participant system records individual accumulation session values and sends them to the program administrator).

Claim 10, 25 and 40:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Marshall, as shown, further discloses methods and a system equivalent to the limitation below:

- *receiving the voucher from the person* (see at least ¶0075, explaining (with reference to Item 180 of Figure 1) how customers that are not previously enrolled are presented with a unique code that identifies their participation in

a credit-worthy activity, the customer then provides this code to the program administrator during enrollment to obtain the credit earned, see also Figure 11, particularly Item 1340, in which individuals initiate accumulation sessions/activities on their own by accessing the system, see also ¶0072, describing a checkpoint system that individuals activate to alert the system of their presence/behavior).

Claim 11, 26 and 41:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Marshall, as shown, further discloses methods and a system equivalent to the limitation below:

- *receiving an electronic file subsequent to a performance of the non-credit behavior* (see at least Figure 5, Items 600 and 635, participant system records individual accumulation session values and sends them to the program administrator),
- *the electronic file comprising a description of the non-credit behavior and an identification of the person, the identification of the person obtained by reading an indicia presented by the person* (see at least ¶0074, individuals provide identification information to the participant electronically, and it is recorded by the system and stored along with a record of the task completed and any previously completed and recorded tasks, see also ¶0054 "the system may issue the individual a unique alphanumeric identification code…").

Claim 13, 28 and 43:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Further, Marshall, as shown, discloses the following limitation:

- *using at least one of e-mail, voice mail, facsimile, mail, an item delivery service, Internet, telephone, diskettes, CD ROM, and an interactive voice*

response system (IVR) (see at least ¶0060, telephone interactions and internet interactions).

Claim 14, 29 and 44:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Marshall does not specifically disclose the following limitation. However, Walker, as shown, discloses the following limitation:

- *the financial account comprises at least one of a credit card account, a financial loan, a checking account, a savings account, and a stock fund* (see at least column 3, line 17, the preferred embodiment of this invention is a credit card account),

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the financial account reward method of Walker with the reward system of Marshall because Marshall suggests that service providers such as credit card companies and utilities could benefit from desirable behaviors such as early account payments (see ¶005) and Walker enables a method for applying such rewards program to such accounts.

Claim 15, 30 and 45:

The combination Marshall/Walker/COSTCO discloses the limitations as shown in the rejections above. Further, Marshall, as shown, discloses the following limitation:

- *the enterprise comprises at least one of a charity, a religious organization, a civic club, a professional organization, a school, a university, a sports organization, a political organization, a government agency, a private corporation, and a public corporation* (see at least ¶0035, describing various examples of participants including blood donor organizations, utility providers, and other service providers like prepaid phone providers).

Response to Arguments

11. Applicant's arguments with respect to claims 1-3, 6-8, 11, 15-18, 21-23, 26, 30-33, 36-41 and 43-45 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923.** The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

14. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

or faxed to **571-273-8300**.

15. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622
21 May 2009

/Arthur Duran/
Primary Examiner, Art Unit 3622